



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,397	11/14/2005	Christian Gehrman	PI7212US2	7189
27045	7590	05/18/2009		
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT 2443	PAPER NUMBER
			MAIL DATE 05/18/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,397

Applicant(s)

GEHRMANN, CHRISTIAN

Examiner

George C. Neurauter, Jr.

Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-22 are currently presented and have been examined.

Response to Arguments

Applicant's arguments filed 24 March 2009 have been fully considered but they are not persuasive.

The Applicant argues that the cited sections of the specification used by the Examiner that was construed to be admitted prior art "are no longer AAPA" since "Applicant has amended the Specification to more clearly define which portions thereof relate to the background of the invention and which portions relate to a description of the invention. Hence, those elements of the present invention which were deemed to be AAPA due to their inclusion in a section of the Specification interpreted as the "background" of "prior art" section of the Specification are now clearly in the portion of the Specification which describe the invention."

The Examiner respectfully disagrees.

The portions of the specification pointed to by the Examiner described "existing" methods and also described the work of others, namely "Baseband Specification" in "Specification of the Bluetooth System, Core, Version 1.1", Bluetooth Special Interest Group". This original disclosure cannot be considered to no longer be admitted prior art merely based on the location of the disclosure within the specification, rather, it is the actual language of the disclosure that controls. Therefore, this subject matter is still considered to be admitted prior art and, as shown previously by the Examiner, taught the claimed invention. Therefore, the claims are not in condition for allowance.

Claim Rejections

Claims 1-4, 6, 8-18, 20, and 22 are rejected in view of the Applicant's admitted Prior Art ("AAPA"). The Applicant described subject matter in the specification at page 3, lines 12-17, page 6, lines 23-29, page 21, lines 13-27, page 22, line 23-page 23, line 2, page 25, lines 5-14, page 25, line 23-page 26, line 2, and page 27, lines 4-12 that was by another, therefore, this statement is construed by the Examiner that this statement constitutes an admission of prior art and any subject matter associated with these statements are construed to be prior art applicable to the claims. See MPEP 2129 and *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). Note that this rejection is separate and distinct from prior art rejections made under 35 USC 102 and 103.

Regarding claim 1, "AAPA" disclosed a method of providing to a client communications device access to a subscription module ("module that is physically inseparable from the server communications device"; see page 9, lines 20-22) of a server communications device, the method comprising the steps of:

establishing a communications link between the client communications device and the server communications device; and communicating a number of messages (M) comprising data related to the subscription module (communicated data using a Bluetooth connection) between the server communications device and the client communications device via the communications link (wireless Bluetooth connection); wherein the method further comprises the step of providing integrity protection ("any method of assuring that information sent from an originating source is not accidentally

or maliciously altered or destroyed during communication from the source to the receiver"; see page 5, lines 12-14 of the specification) of the messages communicated between the server communications device and the client communications device via the communications link. (see at least page 3, lines 12-17 and page 7, lines 1-6 of the specification)

Regarding claim 2, "AAPA" disclosed the method according to claim 1, wherein the step of providing integrity protection further comprises calculating, based on a secret session key, a respective message authentication code for each of the communicated messages; and including the calculated message authentication code into the corresponding communicated message. (see at least page 22, line 23-page 23, line 2)

Regarding claim 3, "AAPA" disclosed the method according to claim 2, wherein the step of establishing a communications link between the client and server communications devices comprises determining a secret session key based on a shared secret between the server and client communications devices. (see at least page 25, line 23-page 26, line 2)

Regarding claim 4, "AAPA" disclosed the method according to claim 3, wherein the method further comprises providing the shared secret by performing a secure pairing procedure including receiving a passcode by at least one of the client communications device and the server communications device. (see at least page 27, lines 4-12)

Regarding claim 6, "AAPA" disclosed the method according to claim 3, wherein the communications link has a secret link key related to it and the method further

comprises providing the shared secret by calculating the shared secret using the secret link key as an input. (see at least page 25, lines 5-14)

Regarding claim 8, "AAPA" disclosed the method according to claim 1, wherein the method further comprises determining, for the messages communicated from the client communications device to the server communications device, whether the message is authorised to address the subscription module. (see at least page 3, lines 12-17 and page 7, lines 1-6 of the specification)

Regarding claim 9, "AAPA" disclosed the method according to claim 8, wherein the method further comprises: providing a shared secret between the client communications device and the server communications device; and providing an access control list stored in the server communications device in relation to at least one of the shared secret and the client communications device. (see at least page 27, lines 4-12) (note that the server specifically interacts with the client using cryptography, therefore, a strong association between the server and the client is established and the cryptographic settings used between the client and the server on the server is considered to encompass the claimed "access control list" where the server is in a generic and nominal relation to the "client communications device", therefore allowing the client access to the server based on the agreed upon cryptographic settings)

Regarding claim 15, "AAPA" disclosed the method according to claim 14, wherein the access control list is stored in a protected database. (note that cryptographic settings are essential to the security of the connection and are stored in confidence at the server and are thus considered to be "protected")

Claims 10-12 are also rejected since these claims recite substantially the same limitations as recited in claim 1.

Claims 13 and 22 are also rejected since these claims recite substantially the same limitations as recited in claims 1 and 8 in combination.

Claim 14 is rejected since this claim recites substantially the same limitations as recited in claim 9.

Claims 16-20 are also rejected since these claims recite substantially the same limitations as recited in claims 2-6 respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over "AAPA".

Regarding claim 5, "AAPA" disclosed the method according to claim 4.

"AAPA" did not expressly disclose wherein the passcode is at the most 48 bits long.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to create a passcode which is at most 48 bits long, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 19 is also rejected since this claim recites substantially the same limitations as recited in claim 5.

Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over "AAPA" in view of US Patent 6,449,473 to Raivisto.

Regarding claim 7, "AAPA" disclosed the method according to any one of claims 2 through 6.

"AAPA" did not expressly disclose wherein the method further comprises: incorporating a value of a first counter in each of the messages communicated from the client communications device to the server communications device, the first counter being indicative of the number of messages communicated from the client communications device to the server communications device; and incorporating a value of a second counter in each of the messages communicated from the server communications device to the client communications device, the second counter being indicative of the number of messages communicated from the server communications device to the client communications device; and wherein the step of calculating a respective message authentication code for each of the communicated messages

comprises calculating a message authentication code for each of the communicated messages and the corresponding counter value, however, Raivisto did disclose these limitations (the counter value being a "sequence number"; see at least column 3, line 66-column 4, line 26)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Raivisto disclosed that using counter values in the calculation of the message authentication code allows for the specific advantage of recalculating the code for stronger security and to enable synchronous recalculation between the client and the server (see at least column 4, line 5-9). Therefore, based on this specific motivation and that the references are analogous to one another in the context of message security and communication security, one of ordinary skill would have been motivated to modify the teachings of "AAPA" to include the subject matter taught in Raivisto in order to arrive at a more robust and secure communication link between a client and a server.

Claim 21 is also rejected since this claim recites substantially the same limitations as recited in claim 7.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571)272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/527,397
Art Unit: 2443

Page 10

/George C Neurauter, Jr./
Primary Examiner, Art Unit 2443